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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,560	12/26/2000	Fridtjov Johansen	JOHANSEN=3	1686

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EXAMINER

PIERCE, JEREMY R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/746,560

Applicant(s)

JOHANSEN, FRIDTJOV

Examiner

Jeremy R. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 1-9 and 13-15 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the restriction is not proper because the method and product constitute one and the same invention and that there is no serious burden to examine both groups of claims. This is not found persuasive because a different method can be used to make the product cited in claim 1, as set forth in the last Office Action, and the two groups are classified in different classes, with the product in class 442, and the method in class 264. The Examiner would consider rejoinder of the non-elected claims upon allowance of claim 1, so long as the method claims contained all limitations set forth in claim 1.

The requirement is still deemed proper and is therefore made FINAL.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Norway on December 23, 1999 and November 22, 2000. It is noted, however, that applicant has not filed a certified copy of the Norwegian applications as required by 35 U.S.C. 119(b).

### ***Specification***

3. The use of the trademark "Station 1" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3, 4, 6-8, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3, 4, and 13 have limitations relating to structure of polyester fiber. However, claim 1 does not "consist of" polyester fiber, because the claim recites that the insulating material is "heat-treated until the polyester fibers melt." The limitations relating to dtex value of the fibers presented in claims 3, 4, and 13 are irrelevant because when the polyester fibers melt, they no longer have characteristics of a fiber. Furthermore, the use of "consisting of" language does not allow for any further limitations not already presented in the claim. The melting point property of the polyester material is still a valid property limitation, but since the Applicant claims the polyester fibers melt, the Examiner must assume that they lose their denier characteristics.

Claims 6 and 7 recite "a fire-retardant agent is added to the insulating material." As set forth above, claims 6 and 7 are indefinite because independent claim 1 closes off the addition of further materials by using "consisting of" language. This reasoning also applies to the addition of "recycled cardboard and/or wastepaper" presented in claim 8.

Claim 6 recites the insulating material has an approved fire resistance "according to standard NT FIRE 035." It is unclear what this standard is referring to, how the test method is performed, and how insulating material that conforms to this standard is limited.

Claim 7 contains the trademark/trade name "Station 1". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a fire-retardant agent and, accordingly, the identification/description is indefinite. The Applicant fails to provide any generic language directed to the chemical and/or structural limitations of what "Station 1" is, except that it is water-based and non-poisonous. Since the Examiner is unable to determine what "Station 1" actually is, the Examiner will assume

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any flame-retarding agent used in insulation would meet the desired function of "Station 1".

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 9, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doerer et al. (U.S. Patent No. 4,418,031) in view of Barrable (U.S. Patent No. 4,101,335).

Doerer et al. disclose an insulating material comprising base and carrier fibers (column 2, lines 43-67). The carrier fibers are melted through heating to bind the base fibers into a molded form (column 6, lines 22-28). The base fibers may be any suitable cellulosic material, such as wood, paper, cotton, or jute, or any suitable synthetic material, such as glass, rayon, acetate or mineral wool (column 3, line 66 –column 4, line 3). However, Doerer et al. fail to teach the base fibers may be flax. Still, flax fibers are recognized in the insulation art as equivalents to the materials disclosed by Doerer et al. Barrable teaches flax to be a useful fibrous cellulosic material in insulation, along with wood, jute, or cotton (column 2, lines 20-26). It would have been obvious to one having ordinary skill in the art to use flax fibers as the base fibers in Doerer et al., since it has been held to be within the general skill of a worker in the art to select a known

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material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Doerer et al. disclose polyester fibers may be used as the melting carrier fiber (column 4, lines 6-7). Doerer et al. also disclose the addition of shoddy material in order to decrease the cost of insulation (column 7, lines 23-26). With regard to claim 2, Doerer et al. teach the fibers may be virgin or reclaimed (column 2, lines 49-50). With regard to claims 3 and 13, Doerer et al. do not teach the melting point of the polyester. The Examiner asserts that the polyester would inherently have a melting point within the broad range of 100-300 °C or the narrower range of 120-170 °C, since Doerer et al. have the same goal as Applicant in the invention (melting the polyester fibers to bind cellulosic fibers in an insulation material). If not inherent, it would have been obvious to a person having ordinary skill in the art to use polyester in the claimed melting point ranges, since it has been held where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. With regard to claims 4 and 14, the carrier fibers comprise between 2 and 30% by weight of the mat (column 4, lines 55-57). With regard to claims 5 and 15, Doerer et al. disclose the base fibers comprise between 70 and 95% by weight of the mat and fail to disclose the range to be within 5-50% by weight or 20-30% by weight. However, lowering the amount of cellulosic fibers in favor of increasing the amount of shoddy would be an obvious modification to a person having ordinary skill in the art, motivated by a decrease in cost. It would have been obvious to one having ordinary skill in the art to lower the amount of base fibers used by Doerer et al. and increase the amount of shoddy fibers, since it has

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been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It should also be noted that using shoddy fibers does not necessarily have to change the chemical make-up of the mat, since shoddy is known in the art to mean re-used. The increase in shoddy material does not have to interfere with amount of cellulosic fibers present in Doerer et al., since it is common that shoddy material may consist only of cellulosic materials to begin with. With regard to claim 9, it would be obvious to a person having ordinary skill in the art to form the insulation material into the claimed dimensions to create an insulation mat with a desired size for its intended use.

8. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doerer et al. in view of Barrable as applied to claims 1 and 2 above, and further in view of Borger et al. (U.S. Patent No. 5,723,209).

Doerer et al. and Barrable do not teach providing a flame-retarding agent onto the fibers. Borger et al. teach adding a flame retardant to fibers in an insulation material to improve the fire protection behavior (column 3, lines 11-14). It would have been obvious to one having ordinary skill in the art to add flame-retarding agent to the material of Doerer et al. and Barrable in order to make the insulation more flame retardant, as taught by Borger et al. With regard to conforming to NT FIRE 035, if not already inherent it would have been obvious to one having ordinary skill in the art to create an insulation that complies with NT FIRE 035 in order to create an insulation that is not too flammable for use in buildings. With regard to claim 7, it would have been obvious to one having ordinary skill in the art to apply 2.5 kg per cubic meter of flame-



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retarding agent to the insulation, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doerer et al. in view of Barrable as applied to claims 1 and 2 above, and further in view of Vost et al. (U.S. Patent No. 5,047,453).

Doerer et al. and Barrable do not teach implementing recycled cardboard and/or wastepaper into the shoddy. Vost et al. teach that shredded waste paper is used in shoddy in making insulation material (column 2, lines 47-48). It would have been obvious to one having ordinary skill in the art to use wastepaper in the shoddy, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

### ***Conclusion***

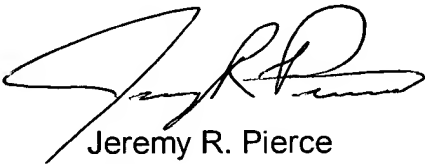
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 6,296,795 to Buck.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703) 605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jeremy R. Pierce  
Examiner  
Art Unit 1771

October 30, 2002



ELIZABETH M. COLE  
PRIMARY EXAMINER